



One Broadway
New York, NY 10004-1050
212.425.7200
Fax 212.425.5288

Fax Transmission

From: **Clifford A. Ulrich** Date: **January 13, 2003**
Direct Dial: **212.908.6079** Fax: **212.425.5288**
Client/Matter: **11150/8** Total number of pages: **3**
(including cover)

Please deliver to:

Name	Company	Fax	Phone
Examiner Eric McCall	United States Patent and Trademark Office	(703) 746-4417	

Comments:

Re: **U.S. Patent Application Serial No. 09/530,936**
METHOD AND DEVICE FOR MONITORING AND/OR DETERMINING
MOTOR OIL QUALITY

☐ Original will not follow ☐ Original will follow by ☐ Regular Mail ☐ Overnight Delivery ☐ Hand
Delivery

The information contained in this facsimile transmission, including any attachments, is subject to the attorney-client privilege, the attorney work product privilege or is confidential information intended only for the use of the named recipient. If the reader of this Notice is not the intended recipient or the employee or agent responsible for delivering this transmission to the intended recipient, you are hereby notified that any use, dissemination, distribution or copying of this communication is strictly prohibited. If you have received this transmission in error, please notify us immediately by telephone, so that we may arrange for its return or destruction at our cost. Thank you.

www.kenyon.com

New York Washington, DC Silicon Valley

Received from <212> at 1/13/03 3:30:40 PM [Eastern Standard Time]

[11150/8]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s) : Detlef PICKERT et al.
 Serial No. : 09/530,936
 Filed : August 18, 2000
 For : METHOD AND DEVICE FOR MONITORING AND/OR
 DETERMINING MOTOR OIL QUALITY
 Examiner : Eric S. McCall
 Art Unit : 2855

I hereby certify that this correspondence is being facsimile
 transmitted to the United States Patent and Trademark Office (Fax.
 No. 703-746-4417) on:

Date: January 13, 2003 Reg. No. 22,490

Signature: Richard L. Mayer
 Richard L. Mayer

Commissioner for Patents
 Washington, D.C. 20231

REQUEST FOR RECONSIDERATION

S I R:

In further response to the Final Office Action of March 14, 2002 and the Advisory Action dated July 9, 2002 and supplementing the Reply Under 37 C.F.R. § 1.116 filed on June 14, 2002, Applicants respectfully request reconsideration of the rejection of claims 33, 36, 39 and 40 under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,888,976 ("Vermeiren") and U.S. Patent No. 6,223,589 ("Dickert et al."). A Notice of Appeal was filed in the above-captioned application on August 20, 2002.

Applicants thank the Examiner for the courtesies extended to Applicants' representative the course of a teleconference on January 13, 2003.

As indicated on page 7 of the Reply Under 37 C.F.R. § 1.116, U.S. Patent No. 6,223,589 issued on May 1, 2001 from U.S. Patent Application Serial No. 09/299,126 ("the '126 application"), filed on April 26, 1999, which purports to be a continuation of PCT/EP99/05748, filed on October 17, 1997. Since the '126 application was filed as a continuation application, rather than as a national stage application, the effective date of Dickert et al. as a reference is its earliest effective filing date, excluding any international filing dates. See, M.P.E.P. § 1896, which states that "[r]egardless of when the application being examined was filed, the effective date as a reference of a patent which has issued from a 35 U.S.C. 111(a) application is always its earliest effective filing date, excluding any

NY01 554070

international filing dates" (emphasis added). Accordingly, since U.S. Patent No. 6,223,589 was filed as a continuation application under 35 U.S.C. § 111(a), rather than as a national stage application, the earliest effective date of Dickert et al. as a reference is April 26, 1999.

The present application was filed under 35 U.S.C. § 371 as a national stage application of International Application No. PCT/EP98/06966. International Application No. PCT/EP98/06966 was filed on November 4, 1998, and the present application entered the national stage on August 18, 2000. As provided by 35 U.S.C. § 363, "[a]n international application designating the United States shall have the effect, from its international filing date under Article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office." Accordingly, the international filing date of November 4, 1998 is considered to be the actual filing date of the present application. Since the actual filing date of the present application of November 4, 1998 is earlier than the earliest effective date of Dickert et al. of April 26, 1999, it is respectfully submitted that U.S. Patent No. 6,223,589 does not constitute a prior art reference against the present application.

Reconsideration and withdrawal of the rejection of claims 33, 36, 39, and 40 under 35 U.S.C. § 103(a) is therefore respectfully requested.

Respectfully submitted,

KENYON & KENYON

Dated:

January 13, 2003

By:

Richard L. Mayer
Richard L. Mayer
Reg. No. 22,490
Reg. No. 42,194

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646



26646

PATENT TRADEMARK OFFICE